

The apparatus claims actually recite a coated container (e.g., “An apparatus . . . comprising a plastic container . . . and a coating on selected portions of said container”) (from claim 1).

The method claims actually recite forming a coating on a container (e.g., “A method . . . comprising coating selected portions of the container with a coating”) (from claim 10).

It is plainly apparent that the method claims recite a method for *making* the container that is claimed in the apparatus claims. On the other hand, it is incorrect to assert that the container is an apparatus that is used for *practicing* the method step of coating the container, i.e., it is technically incorrect to assert that the container is used to coat the container. Something else is used to coat the container--something that is not being claimed.

Therefore, it is plainly apparent that 806.05(e) does not apply, and 806.05(f) (“**PROCESS OF MAKING AND PRODUCT MADE**”) does apply.

According to 806.05(f), the claims are distinct unless

(a) the process is not an obvious way to make the product; or

(b) the product can be made by a materially different process.

Since, by definition, there is no other way to make a coated container than to coat the container, and since coating the container is an obvious way to make a coated container, the claims are distinct according to MPEP 806.05(f), and the restriction requirement was improper.

Claims as Amended

The method claims as amended recite, in addition to method steps of forming a container, a method step of using the container, i.e., for holding semiconductor wafers. Similarly, the amended apparatus claims recite, in addition to a coated container, at least one semiconductor wafer disposed in the container. Again, MPEP 806.05(e) does not apply. Rather, MPEP 806.05(h) (“**PRODUCT AND PROCESS OF USING**”) does apply. According to MPEP 806.05(h), a product and process of using the product are not distinct unless:

- (a) the claimed process of using can be practiced with another materially different product; or
- (b) the claimed product can be used in a materially different process.

Since, by definition, there is no other way to practice a method of using a container to hold at least one semiconductor wafer other than to dispose at least one semiconductor wafer in the container, and since a container having at least one semiconductor wafer disposed therein cannot result *without* using the container to hold one or more semiconductor wafers, the claims are distinct according to MPEP 806.05(h).

For these reasons, the restriction requirement was improper and continues to be improper.

Section 102 Rejections

The claims stand rejected under 35 USC §102(b) as being anticipated by Taoda et al., U.S. Patent No. 5,562,820 (“Taoda”).

Applicant is not aware whether “titanium oxide” as referred to in Taoda, which could be referring to TiO , Ti_2O_3 , or Ti_3O_5 as well as TiO_2 , inherently has the same properties as the titanium dioxide (TiO_2) claimed. The claims have been amended in case all these substances are equivalent in terms of the functions described in the specification. However, if all of these substances are in fact not equivalent, Applicant is not conceding by making the amendment that they are.

The claims also stand rejected under 35 USC §102(b) as being anticipated by Goto et al., U.S. Patent No. 6,235,358 (“Goto”). The amendments render these rejections moot; however, Applicant has proved beyond all legal requirements that Goto teaches a coating layer that differs materially from the coating layer claimed and maintains this position.

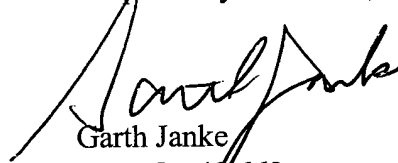
Section 103 Rejections

The claims are asserted to be obvious modifications of Goto et al., or Taoda in light of Nyseth, U.S. Patent No. 5,575,394 (“Nyseth”). Essentially, the Office Action alleges that either Goto or Taoda could be used to store any object, and Nyseth teaches storing semiconductor wafers in a plastic container to minimize particulate contamination. However, there has been no showing of any teaching or suggestion in the prior art to modify the plastic container of Nyseth to include either the coating of Goto or the coating of Taoda. Nyseth teaches a plastic container without any such coating, and neither Goto nor Taoda suggest using titanium dioxide in a container for minimizing particulate contamination generally, or for storing semiconductor wafers particularly.

It is reiterated that Goto is inapposite because it teaches a coating layer that differs materially from what is claimed. In addition, the mere assertion that the container of Goto could be used to store any object is not a *prima facie* case that it is obvious to modify Nyseth. See MPEP 2143.01 (**“FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS”**). Taoda is inapposite because it teaches using a coating in a “vessel” for storing water, which teaches or suggests nothing about using such a coating in a container for storing dry semiconductor wafers. Furthermore, the purpose of the titanium oxide taught in Taoda is to decompose bacteriologically resistant substances (col. 2, lines 39 - 49), not to minimize particulate contamination.

For the foregoing reasons, it is respectfully submitted that claims 1, 3, 4, 10-14, 21, 26, and 27 are all in condition for allowance and should issue in a single patent, and the Examiner is respectfully requested to withdraw the rejections as well as the restriction requirement and pass the entire case to issue.

Respectfully submitted,



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